

REMARKS

The office action and prior art references that have been cited have been carefully considered together with the present application. Claim 16 has been deleted and amendments have been made to claims 1 and 20 to emphasize pre-existing differences between the prior art now cited and applied and the invention as claimed.

The examiner has now recognized that Luttmer failed to anticipate claims 1, 3-5 and 19-20 as asserted in the prior office action and has now rejected many of these claims and others, namely, 1, 3-5, 7-9 and 15-19, under 35 USC 103(a) over Luttmer in view of newly cited Pechak.

It is strongly believed that Luttmer in view of Pechak fails to teach or suggest the table saw as defined in amended claim 1. The examiner sets forth extensive remarks describing how Luttmer meets various elements of the claim, but then admits that Luttmer does not disclose that the fence has the features of the final element of the claim as it existed before the present amendment. However amended claim 1 has now been amended to read, *inter alia*, said fence having a fixed elongated protrusion configured to engage a recess in said member when said fence is lowered onto said fence rail, whereby said fence cannot be moved relative to said member in the longitudinal direction of said fence rail, said protrusion separating from said recess when said fence is lifted from said fence rail.

Before discussing the merits (or lack of) of the two patents, applicant contends that there is certainly no motivation to combine Luttmer and Pechak and it is strongly believed that the combination is improper because it is a result of the application of improper hindsight. Pechak has nothing to do with a table saw having a measurement and display system. It does not have a fence rail or a fence and deals with mounting a separate position measuring device onto an auxiliary device that is not on the "embodiment of measure". The examiner suggests that the Pechak device teaches a method and apparatus for mounting a position measuring device for measuring the

relative position between two objects such as a bed (machine table) and the carriage (fence) of a machine (table saw). It is almost incomprehensible that one of ordinary skill in the art would equate the described machine table as a bed or the carriage as a fence or a machine as a table saw. It defies reality and common sense.

There is no discussion whatsoever of anything that approaches a fence and the mere fact that it includes clamping screws 9 and 10, both of which are necessarily threaded because of the characterization of them as being a screw and the fact that they both have a hex head which is provided for turning does not meet the language of the claim relating to a protrusion or its functionality in the context of the claim.

Even if one could combine Luttmer and Pechak, the combination fails to teach or suggest claim 1 for several reasons. First, claim 1 now recites that the fence has a fixed elongated protrusion. The clamping screws 9 and 10 are not *fixed*, but are removable. In fact, the examiner even states that Pechak further discloses another attachment means (clamping screw 10) in which the sensing apparatus is still *easily removable* from the fence. Claim 1 now states that the fixed elongated protrusion is configured to engage a recess in said member when said fence is lowered onto said fence rail whereby said fence cannot be moved relative to said member in the longitudinal direction of said fence rail, said protrusion separating from said recess when said fence is lifted from said fence rail. This structure and functionality is simply not present or suggested by Pechak, applied singularly or in combination with Luttmer.

With regard to claim 20, it has now been amended to define a member physically connecting said sensing unit, said display unit and said processing unit together, said fence having a fixed elongated pin extending downwardly and being configured to engage a generally vertically oriented slot in said member when said fence is lowered onto said fence rail whereby said fence cannot be moved relative to said member in the longitudinal direction of said fence rail, said pin separating from said slot when said fence is lifted from said fence rail.

Clearly Luttmer fails to teach or suggest such structure and Morrison fails to supply the deficiency. Morrison simply has no fence whatsoever and is not even remotely directed to a table saw. It is a tape scale applicator that measures a movable part which is stated to be a carriage or gantry of a machine relative to a fixed part which may be the bed of a machine or another carriage or gantry. The summary of the invention states that misalignment of the tape relative to the path of the read head will inevitably result in reduced accuracy measurement readings and that the present invention attempts to overcome the difficulty of misalignment of the tape by providing a method and apparatus of applying a tape to a substrate according to the appended claims.

This has nothing to do with a table saw, much less a linear measurement and display system for a table saw that has a removable fence and it is believed to be almost inconceivable that one of ordinary skill in the art would be able to combine the teachings of Morrison with Luttmer in any meaningful way. The examiner's statement that it is held that rearranging parts of an invention involves only routine skill in the art misstates the law of obviousness by relying upon *In re Japikse*, which is totally misplaced.

In re Japikse, 86 USPQ 70, is a 1950 CCPA decision and does not even begin to correctly state the law of obviousness that has evolved in the last 55 years, particularly since the establishment of the Court of Appeals for the Federal Circuit. *In re Japikse*, is not found to have ever been cited by a federal district court in a patent case or in the Court of Appeals for the Federal Circuit in any appeal, and the examiner's reliance upon this case is totally misplaced. In fact, in subsequent decisions, the Board of Patent Applications and Interferences, has criticized the decision. For example, in *Ex Parte Boris E. Makutonin, Frank G. Oliverio And Matthew J. Zdinak*, (unpublished) the Board stated: In the present case, the examiner fails to advance any factual basis to supply the admitted deficiencies of Scarpa vis-a-vis the subject matter recited in independent claims 1, 16, 24, 35 and 36. Instead, the examiner attempts to bridge Scarpa's evidentiary gaps by resort to so-called mechanical or per se rules of obviousness allegedly established by

the *St. Regis* and *Japikse* cases. Such rules do not exist, however, and the reliance thereon by the examiner to establish obviousness under section 103(a) is improper. See *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995); *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965).

Also in *Ex Parte Stuardo A. Robles, Thanh Pham And Bang C. Nguyen*, (unpublished) the board stated: “The examiner cites *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) for the general proposition that “a mere shifting the location of parts” of an apparatus is a matter of obviousness for the skilled artisan (page 4 of Answer). However, our review of the case reveals no such proposition or rule of law.”

A more accurate statement of the law of obviousness is set forth in the following cases. Each prior art reference must be viewed in its entirety and the Court cannot ignore portions that argue against obviousness. *Bausch & Lomb, Inc. v. Barnes-Hind Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986), citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983).


As this court has stated, virtually all [inventions] are combinations of old elements. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2 693, 698, 218 USPQ 875, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 159-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (Most, if not all, inventions are combinations and mostly of old elements.). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability. *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). *In re Denis Rouffet, Yannick Tanguy and Frederic Berthault*, (Fed. Cir. 1998).

The independent claims 1 and 20 are not taught or suggested by the prior art cited or applied. Also, the dependent claims necessarily incorporate the features of the independent claims from which they depend and in addition recite other features and functionality. For these reasons, the dependent claims are also believed to be in condition for immediate allowance.

Reconsideration and allowance of all pending claims is respectively requested.

Respectfully submitted,

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